

III. Remarks

A. Status of the Application

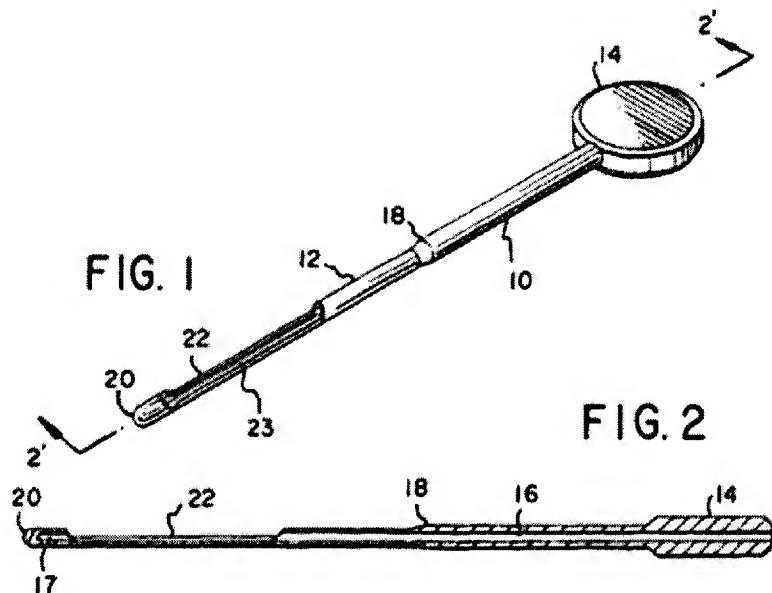
Claims 1, 4, 12, 23, 24, and 25 will be pending after entry of this paper, of which, claim 1 is in independent form. By this paper, claims 1, 23, and 24 are amended. Claim 25 has been added by the present paper. Reconsideration of the presently pending claims is respectfully requested in light of the above amendments and the following remarks.

B. Claim Rejections - 35 USC § 103

The Office Action rejected claims 1, 4, 12, 23, and 24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,248,110 to Reiley et al. (“Reiley”) in view of U.S. Patent No. 5,545,136 to Berger (“Berger”). Applicants respectfully traverse the rejection on the grounds that the cited reference is defective in establishing a *prima facie* case of obviousness.

With respect to amended independent claim 1, even when combined, Reiley and Berger do not disclose or suggest the applicants’ claimed method step of “providing a tool comprising a hollow body including a circumferential wall having a distal end, the tool also comprising an extension that protrudes from the circumferential wall beyond the distal end and forms a platform that is open in a radial direction to form a radial direction opening and in an axial direction to form an axial direction opening that is substantially transverse to the radial direction opening, the platform having a side surface facing in the radial direction.” The Office Action states that Reiley “does not teach a platform that is open in a radial direction and has a side surface facing the radial direction.” Office Action, p.3. The Examiner relies on Berger for these teachings. However, even when combined, Reiley and Berger do not disclose all of the recited features of amended independent claim 1.

Referencing FIGS. 1 and 2 reproduced below from Berger, the Examiner identified cutout portion 22 of tube 12 as corresponding to the claimed platform.



However, as clearly shown above, tube 12 has a closed distal end 20 adjacent cutout portion 22. In fact, as shown below in FIG. 3, it appears that Berger teaches or suggests that close distal end 20 (number not shown) functions as a stop such that “[t]he seating of the catheter allows the balloon portion 25 to be positioned in cutout portion 22 . . .” Berger, col.4 ll.66-67.



FIG. 3

Therefore, Berger does not disclose or suggest “a platform that is open in a radial direction to form a radial direction opening and in an axial direction to form an axial direction opening,” as recited by amended independent claim 1. Layne does not cure these deficiencies. Accordingly, even when combined, Reiley and Berger do not teach or suggest all of the recited features of claim 1.

Claims 4, 12, 23, and 24 depend from and add additional features to claim 1. Thus, claims 4, 12, 23, and 24 are allowable for at least the same reasons as discussed above for claim 1. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw the rejection and pass claims 1, 4, 12, 23, and 24 to allowance.

C. New Claim

New claim 25 has been added and recites a combination of features not taught or suggested by the cited references. In particular, new claim 25 recites:

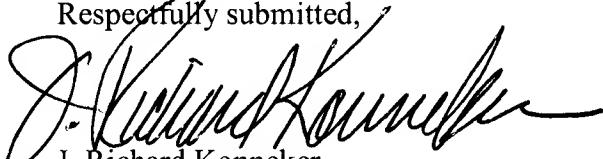
25. (New) The method according to claim 1, wherein forming the cavity in the second region of cancellous bone includes expanding the expandable structure in the axial direction through the axial direction opening of the platform such that the expandable structure expands in the axial direction beyond a distal end of the platform.

Claim 25 depends from and further limits independent claim 1. Accordingly, Applicants respectfully submit that new claim 25 is patentable over the cited references.

IV. Conclusion

In view of the foregoing remarks, all of the claims currently pending in this application are in a condition for allowance. A telephone interview is respectfully requested to discuss any remaining issues in an effort to expedite the allowance of this application.

The Final Office Action contains characterizations of the claims and the related art of which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Final Office Action.

Respectfully submitted,

J. Richard Konneker
Attorney for Applicants
Registration No. 28,867

Date: December 23, 2009
HAYNES AND BOONE, LLP
Telephone: 972-739-8612
Facsimile: 214-200-0853
R-242734_1.DOC

<p style="text-align: center;"><u>Certificate of Service</u></p> <p>I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via EFS-Web on <u>December 23, 2009</u> <u>Crystal French</u> Crystal French</p>
